

REMARKS/ARGUMENTS

In response to the Office Action mailed October 9, 2003, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. Claim 1 was amended, no claims have been added, and claims 3 and 10 were previously cancelled without prejudice so that claims 1, 2, 4-9 and 11-15 remain pending. No new matter has been introduced.

Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,425,898 to Wilson et al. (Wilson) in view of U.S. Patent Number 5,176,660 to Truckai (Truckai). Claims 8-9 and 11-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of U.S. Patent Number 4,705,511 to Kocak (Kocak). These rejections are respectfully traversed.

Section 103(a) of United States Code Title 35 states that subject matter developed by another person, which qualifies as prior art under one or more subsections (e), (f), and (g), of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person, or subject to an obligation of arrangement to the same person.

It is respectfully submitted that according to the Examiner, Wilson qualifies as prior art under 35 U.S.C. § 102(e). It is also respectfully submitted that at the time the invention was made, the subject matter and the claimed invention were subject to an obligation of assignment to the same entity. This obligation exists in the inventors' employment agreements as evidenced by the newly executed Assignment of the present invention to Cordis Corporation. Accordingly, under 35 U.S.C. § 103, Wilson cannot be used in making an obviousness type rejection under 35 U.S.C. § 103(a). Without Wilson, Truckai and Kocak fail to disclose or even remotely suggest the claimed invention. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.


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Applicants would be willing to interview the present case if the Examiner so desires. Accordingly, the Examiner is invited to call the undersigned at (732) 524-2518 if such a call would facilitate the prosecution of this application.

A favorable action on the merits is earnestly solicited.

The Commissioner is hereby authorized to charge any fee pursuant to 37 C.F.R. §116 and any other fee that may be due to Deposit Account No. 10-750/CRD-0940/CJE.

Respectfully submitted,

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